

### REMARKS

Applicants select Group I for examination, with traverse. Applicants submit that in the event that either claim 1 is considered to be patentable or claims 1 and/or 33 are amended to have the same limitations as an allowable claim 1, then the restriction requirement (actually a non-unity requirement) would be mooted.

While the present office act was not an action on the merits, applicants do make the following remarks with respect to the cited prior art.

US 5,827,627 does describe the silica as having a size of 2000-9000 nanometers. However, this means that the silica is between 2 and 9 microns in size. Just as stating a distance of a meter as being 1,000,000,000 nanometers would not change it into a nanometric distance, stating a micron size in nanometers does not make the silica into nanosilica.

The Examiner has supplied a machine translation of JP 09-114122. As is well known such translations are very poor and almost unreadable. This translation is no exception. However, on reading the entire document it becomes apparent that the reference describes a system very similar to that described in US 5,612,281 which was cited in the PCT and which should be available to the Examiner.

Claim 1 has been amended to include the limitation of claim 31 in it. As such it comes in place of claim 31, and is not, *per se* an amendment of an existing claim. This limitation of being a film is inherent in the way the coating is produced (as opposed to the method of the JP reference) as is the continuous nature of the film and its smoothness.

In addition, the Examiner will note that many of the dependent claims distinguish over this art.

Furthermore, applicants question the Examiner's reliance on the abstract for the size of the silica, since the specification of the reference itself, as translated, is not clear on this point.


Since the Examiner has available to him an "oral translation" service (in addition to other such translation services), the structure of the coating defined in the JP reference and the sizes and weight percentages of the silica material (with respect to what is also equivocal), can be easily clarified, prior to the first office action on the merits.

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A marked-up version of the amended claims is attached hereto.

An action on the merits is respectfully awaited.

Respectfully submitted,  
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**Marked-Up Amended Claims**

1. (Amended) A printing method comprising:

providing a substrate having a surface coated with a film coating comprising at least 25% nano-silica by weight; and

printing on the coated surface with a liquid toner comprising pigmented polymer particles and a carrier liquid.

31. (Twice Amended) A printing method according to claim 1 wherein the surface of the coating is [film] continuous.

32. (Amended) A printing method according to claim [31] 1 wherein the coating is smooth.